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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,127	02/19/2004	Kwang-wook Oh	KCL0097US	2678

23413 7590 02/04/2011
CANTOR COLBURN LLP
20 Church Street
22nd Floor
Hartford, CT 06103

EXAMINER

BEISNER, WILLIAM H

ART UNIT	PAPER NUMBER
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1775

NOTIFICATION DATE	DELIVERY MODE
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02/04/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary	Application No. 10/783,127	Applicant(s) OH ET AL.	
	Examiner WILLIAM H. BEISNER	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,7-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/4/2010 has been entered.

Election/Restrictions

2. Applicant's election of Group I, Species i), in the reply filed on 6/27/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 3-5, 7-14 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/27/2007. Note, Applicants did not state which claims encompass the elected species. As a result, it is determined that claims 6 and 15 correspond to elected species i) while claims 1 and 2 are generic. Therefore, claims 1, 2, 6 and 15 will be examined on their merits.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhao et al.(US 2002/0079219).

With respect to claim 1, the reference of Zhao et al. discloses a device capable of PCR (Figures 1, 6 and 8) that includes an inlet (26, 608); an outlet (26); a PCR channel (14, 460, 604); a heat source (454, 602). The portions of the PCR channel near the inlet and the outlet of the PCR device are structurally capable of holding a sol-gel material and functioning as first and second micro-valves because the structure disclosed by the reference of Zhao et al. is structurally capable of being used with a sol-gel material positioned within the microchannels which function as microvalves. Note "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)) (See MPEP 2115). The reference of Zhao et al. does not include additional heat sources and/or valves.

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With respect to claims 2 and 17-19, the structure of the device of Zhao et al. is structurally capable of being used with the material recited in claims 2 and 17-19.

6. Claims 1, 2 and 17-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Koh et al. (Anal. Chem.).

With respect to claim 1, the reference of Koh et al. discloses a device capable of PCR (Figure 1) that includes an inlet (6 or 8); an outlet (5 or 7); a PCR channel (PCR region); a heat source (See "PCR Setup" page 4593). The portions of the PCR channel near the inlet and the outlet of the PCR device are structurally capable of holding a sol-gel material and functioning as first and second micro-valves because the structure disclosed by the reference of Koh et al. is structurally capable of being used with a sol-gel material positioned within the microchannels which function as microvalves. Note "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)) (See MPEP 2115). The reference of Koh et al. does not include additional heat sources and/or valves.

With respect to claims 2 and 17-19, the structure of the device of Zhao et al. is structurally capable of being used with the material recited in claims 2 and 17-19.

Response to Arguments

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7. With respect to the rejection of Claims 1, 2 and 17-19 under 35 U.S.C. 102(b) as being anticipated by Wilding et al.(US 5,587,128), this rejection has been withdrawn in view of Applicants' amendments to the claims and related comments (See pages 6-8 of the response filed 6/4/2010). However, new grounds of rejection have been made over the references of Zhao et al.(US 2002/0079219) and Koh et al.(Anal. Chem.).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM H. BEISNER whose telephone number is (571)272-1269. The examiner can normally be reached on Tues. to Fri. and alt. Mon. from 6:15am to 3:45pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael A. Marcheschi, can be reached on 571-272-1374. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**/William H. Beisner/
Primary Examiner
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WHB